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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/944,379
Filing Date: September 04, 2001
Appellant(s): MODEREGGER ET AL.

MAILED

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GROUP 3600

Martin E Miller
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on August 20th, 2007 appealing from the Office action mailed on December 1st, 2006.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

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US 2002/0069154	Fields	6-2002
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US 2002/0077954	Slaight et al.	6-2002
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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 - 3, 7-10, 13-15, 18, 19, 26, 33, 38-41, and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Fields [US 2002/0069154].

As per claims 1, 2, 12-15, 18, 19, 26, 33, 38-41, and 43, Fields discloses a computer-implemented method for fulfilling an invitation for bids, comprising: providing a database [see flowchart of figure 1, block 14], comprising at least one performance description and at least one price description for each of a plurality of predetermined performances [see paragraph 55]; generating a list of unpriced performances [see paragraph 93] desired by a buyer by selecting at least one of the predetermined performances from the database and by including the respective performance description in the list of performances [see abstract of the invention and see paragraphs 19, 24, 26, and 67]; forwarding the list of unpriced performances to a plurality of bidders, receiving a bid from at least one of the plurality of bidders [see abstract (e.g. **means for receiving bids**), and paragraph 27 (e.g. **means for distributing request for proposal**)], each received bid including a bid price input to a bid mask by the bidder and assigned to at least one performance description of the list of unpriced performances, the bid price stating the price to be paid to the bidder for effecting the respective performance by the bidder [see first paragraph of the summary of the invention (e.g. customized fee quote based upon **client inputs**)]; evaluating the received bids and selecting a

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bid from the bids received [see paragraph 86 (e.g. figures 21 and 24, after the client completes a request, he is taken to a page which lays out a **calculated fee and RFP** based the information input into the system)]; and updating the database such that, for each performance of the generated list of performances for which a bid is selected, the price description in the database corresponding to said performance is modified to reflect the selected bid, wherein at least the updating is performed by a computer [see paragraph 28].

As per claims 3 and 12, Fields discloses generating the list of performances includes modifying at least one performance description in the list of performances, and wherein updating the database includes automatically updating the price description corresponding to bid performances whose performance description was not modified [It is noted that the performance description is updated, for example specifying a number of moving parts in the invention, and see paragraph 62, via client **Start Page 56A** permits the client to **renew** and delete].

As per claims 7-9, Fields discloses the step of generating the list of performances also includes generating an estimated bid which includes an estimated price for at least one desired performance of the a generated list of performances [see paragraph 47].

As per claim 10, Fields discloses the price description of the performance in the database comprises prices independent of the region in which the predetermined performance is to be effected, and wherein the database further comprises at least one regionally dependent price correction term for a plurality of regions in which the predetermined performance is to be effected [see paragraph

80 (e.g. in the database 14 based upon empirical evidence of ***regional and national prices*** for intellectual property services)].

Claims 4 - 6, 11, 16, 20, 21, 34-36, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fields.

As per claims 4-6, Fields shows all elements except modifying or adding a performance and saving it in the database as a new performance. However, the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method Fields by modifying or adding and saving performance descriptions as new performances in order to provide a more comprehensive listing of performance descriptions for future users to choose from.

As per claim 11, Fields shows all elements except determining the price of a performance from the region-independent price and a regionally dependent price correction term and updating only the independent price. However, the examiner takes official notice that to determine and update a regional price in this way is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method Fields by applying a regional correction term to an independent price in order to facilitate easy database maintenance.

Additionally as per claim 11, Fields shows all elements except providing regionally dependent price correction term and determining the price of a performance from the region-independent price and a regionally dependent price correction term. However, it would have been an obvious matter of design choice

to determine regional prices in this way since it does not appear that this particular method of determining regional prices solves a particular problem or is for a specific purpose, and it appears that the method would function equally well with either method.

As per claim 16, Fields shows all elements except securing the list upon its completion. However, the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to secure the created list in order to ensure that the list is not changed during the bidding process, creating inaccurate bids.

As per claim 20, Fields shows all elements except not disclosing the bid to the buyer. However, the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to maintain bids secret until the deadline in order to prevent bid rigging.

Additionally, it is noted that claim 20 is interpreted as an obvious variant over claim 19. Were it determined that claim 20 is patentably distinct from claim 19, a species requirement would be necessary.

As per claim 21, Fields shows all elements except showing time of receipt of a bid. However, the examiner takes official notice that to do so is notoriously old and well known. It would have been obvious to one of ordinary skill in the art to include the time of receipt in order to maintain good housekeeping records and to provide proof that the bid arrived before the deadline.

As per claim 34, Fields shows all elements except automatic notification of losing bidders. However, the examiner takes official notice that to do so is

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notoriously old and well known in the art (e.g., eBay). It would have been obvious to one of ordinary skill in the art to modify the method Fields by providing such notification in order to ensure timely notification of losing bidders.

As per claims 35 and 36, Fields shows all elements except automatically sending a list of performances to the winning bidder. However, the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to generate and provide such a list in order to facilitate the creation of a contract between the bidder and buyer in a timely manner.

As per claim 42, Fields shows all elements except the price description comprising a performance description comprising time to perform a performance, and a rate per hour. However, the examiner takes official notice that to do so is notoriously old and well known in the art (e.g., determining the cost of an auto repair by retrieving the "book rate" time to perform the repair and multiplying it by the labor rate). It would have been obvious to one of ordinary skill in the art to modify the method of Fields by providing such a way of determining the price in order to quickly determine a price of a number of jobs based on differing complexity and labor costs.

Claims 17, and 27 - 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fields in view of Slaight et al. [US 2002/0077954].

As per claims 17, 31 and 32, Fields discloses all elements per claimed invention as explained above. Fields does not explicitly disclose receiving bids includes receiving several bids from each of several bidders, with the last bid

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received from each bidder being used for bid evaluation and selection; the bids are made available to a chosen few of the submitting bidders such that each of the chosen bidders can inspect the bids of the remaining chosen bidders, and wherein each of the chosen bidders can submit modifications of their respective bid prices; and an auction end time is determined after which modifications can no longer be received.

However, Slight discloses receiving bids includes receiving several bids from each of several bidders [see abstract of the invention], with the last bid received from each bidder being used for bid evaluation and selection [see paragraph 57 (e.g. the implementor may **evaluate the suitability of the auction** for the category using many different criteria)]; the bids are made available to a chosen few of the submitting bidders such that each of the chosen bidders can inspect the bids of the remaining chosen bidders [see figures 25A and 25B], and each of the chosen bidders can submit modifications of their respective bid prices [see paragraph 75 (e.g. modify pre-existing information), and figure 6]; and an auction end time is determined after which modifications can no longer be received [see paragraph 89 (e.g. duration of the auction including the start date time and end date time)].

Therefore, it would have been obvious to one of ordinary skill in the art to modify the method of Fields by providing feedback and allowing repeated bids in order to assist the bidder in fixing problems in his bid.

As per claims 27-30, Fields discloses all elements per claimed invention as explained above. Fields does not explicitly disclose generating a synthetic price

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from the ideal price calculated from the bid prices, and making the price available to bidders.

However Slight discloses generating a synthetic price from the ideal price calculated from the bid prices [see e.g., Figure 33]; and making the price available to bidders [see figure 16A].

Therefore, it would have been obvious to one of ordinary skill in the art to modify the method of Fields by providing a synthetic price as claimed in order to assist in evaluating bids.

. Claims 22-25, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fields in view of Vashistha et al. [2001/0051913].

As per claims 22 and 23, Fields in view of Vashishta show evaluating the bids based on ideal price (comprising lowest price), estimated price, deviation from the lowest price and past performance,

As per claims 24 and 25, Fields in view of Vashishta show all elements except automatically determining a deviation from the ideal price. However, to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to further modify the method of Fields by providing a deviation in order to assist in determining the best bid.

As per claim 37, Fields discloses all elements per claimed invention as explained above. Fields does not explicitly disclose the selected bid is selected automatically.

However, Vashistha disclose the selected bid is selected automatically [see paragraph 90 (e.g. **automatically populated**)]. Therefore, it would have been

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obvious to one of ordinary skill in the art to modify the method of Fields by automatically selecting a bid in order to reduce the amount of manual labor required in selecting the bid.

(10) Response to Argument

In response to the Appellants' argument that the rejection did not addressed the amended language of "unpriced performances". Contrary to the appellant's assertion, the Examiner respectfully submits that the recitation of "unpriced performances" neither enhances nor diminishes the functionality of the system. This information is nothing but a description of a generalist of unpriced performances, which coincides with the definition of non-functional descriptive material in MPEP 2106. In conclusion, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given any patentable weight.

The Examiner understands that the definiteness of the language employed must be analyzed - not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art, and also a claim may appear indefinite when read in a vacuum, but may be definite upon reviewing the application disclosure or prior art teachings.

Appellants argue with respect to claims 3 and 12 that the functions from the cited reference (Fields) are unrelated to the "generating" and "updating". Contrary to the appellant's assertion, the Examiner respectfully submits that Fields discloses

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generating the list of performances and updating the database including updating the price description corresponding to bid performances whose performance description was not modified. In Fields, it is noted that the performance description is updated, for example specifying a number of moving parts in the invention, and see paragraph 62, via client **Start Page 56A** permits the client to **renew** and delete.

Appellants argue with respect to claim 14 that Fields publication does not address the feature of the claim. Contrary to the appellant's assertion, the Examiner respectfully submits that Fields discloses determining a plurality of bidders to which to forward the list of performances is based on a history of past performance by the bidders. Fields discloses a control unit for receiving a client request generated by a prospective client, relating to a desire for legal services including a fee request; means for assisting a client in formulating a request for proposal to be distributed to a patent attorney throughout the system; means for distributing the request for proposal to said attorneys; and means for receiving bids from attorneys who receive the request for proposal [see abstract].

In response to applicants' arguments regarding claims 22 and 23 that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21

USPQ2d 1941 (Fed. Cir. 1992). In this case the references are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. It is necessary to consider the reality of the circumstances, in other words, common sense in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. *In re Wood*, 599 F.2d 1032, 1036, (C.C.P.A. 1979). A reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as basics of rejection. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

Appellants argue with respect to claim 38 that the statement of rejection does not substantively address the claim. Contrary to the appellant's assertion, the Examiner respectfully submits that Fields discloses a control unit for receiving a client request generated by a prospective client, relating to a desire for legal services including a fee request. It is noted that the performance description is updated, for example specifying a number of moving parts in the invention, and see paragraph 62, via client **Start Page 56A** permits the client to **renew** and delete.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Garcia Ade



Conferees:

Ryan Zeender



F. RYAN ZEENDER
PRIMARY EXAMINER

Vincent Millin

